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Robert C. Angell

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EXAMINER

SAGER, MARK ALAN

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,851	<b>Applicant(s)</b> ANGELL ET AL.	
	<b>Examiner</b> M. Sager	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-26 and 28-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/05/09 has been entered.

***Priority***

2. The later-filed application must be an application for a patent for an invention that is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The disclosure of the prior-filed grandparent Application No. 08844764, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The Office maintains that grand-parent application no. 08844764, U.S. Patent No. 5938200, fails to provide adequate support or enablement for any step/feature of each pending claim as would be interpreted by an artisan; thus, priority of instant application is as of the filing date of parent 09342150, which was filed June 29, 1999. Facts of prosecution shows that Patentee filed a Certificate of Correction in parent application 09342150 that altered continuation data from 08844794 to 08844764 to remove '794 from record. Any change of continuation data must be provided within parent file. Applicant is reminded of timing of claiming priority. 37 CFR 1.78.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to adequately support claimed invention regarding the form of invention that includes wireless communication of encryption code as claimed by communicate an encryption code to the wireless gaming device prior to the wagering information being entered by the player (clm 1-20), communicating an encryption code to the wireless gaming device (clm 21-26), using an encryption code received by the wireless gaming device before the wireless gaming device prior to the entry of the wagering information (clm 28-43), and communicating an encryption code to the wireless device prior to the entry of wagering information by the player (clm 44) in so far as the language continues to include wireless communication; however, the disclosure teaches that the encryption code is stored in the player device and changing the code by direct connection (paras 39-40 of PG PUB 20050070358) such there is no wireless communication of encryption code timed prior to wagering by player. Thus, the original disclosure fails to provide adequate support to permit public notice regarding the form of claimed invention that encompasses wireless communication of encryption code to wireless player device and remarks do not indicate support for such form.

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5. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for wired transmittal of encryption code to player device, does not reasonably provide enablement for wireless communication of encryption code to player device. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Essentially, the specification states in part in paragraphs 39-41 of PG PUB 20050070358 that the wireless gaming device may store an encryption key, the encryption key 32 is preferably stored in EEPROM 34 and that the encryption key 32 stored in EEPROM 34 may be updated and changed for each player who receives wireless gaming device 20 *by directly connecting device 20 to encoding and decoding circuitry 82 in terminal 50 through port 84.*

Thus, there is no wireless transmittal of encryption code disclosed to provide public notice.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-26 and 28-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Where the claimed communication includes wireless, it is unclear what device wirelessly communicates an encryption code to the wireless gaming device prior to the wagering information being entered by the player (clm 1-20), communicating an encryption code to the wireless gaming device (clm 21-26), using an encryption code received by the wireless gaming device before the wireless gaming device prior to the entry of the wagering information (clm 28-43), and communicating an encryption code to the wireless device prior to the entry of wagering information by the player (clm 44) where the form of communication of

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the encryption code is wireless since the disclosure teaches that the encryption code is stored in the player device and can change the code by direct connection via port (paras 39-41 of PG PUB 20050070358) such that there is no wireless communicating of encryption code prior to wagering by player; however the breadth of claimed communication and receiving of encryption code includes wireless and there is no evidence that demonstrates such form of communication or receipt of code was disclosed in manner to put public in possession of what was invented regarding the form of communication being wireless since claims are not specified to preclude.

### ***Claim Interpretation***

8. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) adapted to or adapted for clauses; (B) wherein clauses; and (C) whereby clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.* In this case, the ‘wherein’ clauses have been treated as if the particular limitation in each respective clause states a

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condition that is material to patentability; however, such narrow interpretation is generous since each of the claimed optional functions is not material to patentability.

9. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the claimed function does not distinguish over structure of prior art performing same function for same purpose.

***Claim Rejections - 35 USC § 102***

10. Claims 1, 4-6, 8-12, 15, 17-18, 20-21, 23-24, 26, 38-41 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (WO 96/00950). This holding is maintained from prior action for cited claims, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. As best understood with broadest reasonable interpretation of claims, Walker discloses a system, wireless gaming device and method teaching claimed steps/features (abstract, 3:2-13:32, figs. 1-15D) including a wireless hand held gaming device (ref 14, 82, handheld portable device, PDA, laptop), comprising an id code identifying the wireless gaming device and uniquely associated with

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player and/or gaming device (abstract, 3:2-13:32, 16:21-18:17, 19:2-23:22, 24:15-26, 25:3-26:34, 33:9-33:36, 34:24-36:8, ref 14, 32, 34), entry apparatus (abstract, 3:2-13:32, 15:22-16:18, 21:23-30, figs. 1-15D, ref 20, 82, 84, 86, 91, 93) configured to receive wagering information entered by a player as representing a wager request entered by a player to include command and data to form a bet comprising a string of characters (abstract, 3:2-13:32, 21:23-30, 22:9-27, 23:4-33, 25:3-26:34, 29:18-41:23, figs. 1-15D), a transmitter configured to transmit a signal by radio frequency (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs. 1-15D; handheld portable device, PDA or laptop from Walker includes transmit/receive by radio frequency; as further evidence under MPEP 2131.01 as requested on page 17 of remarks, see Franchi 5770533 @ abstract, 15:15-37, figs 12, 15-16; Jonstromer WO96/32700 @ abstract, figs 1-2, ref 8; Schneier 5871398 @ 11:1-12:53, figs 1-13, ref 113, 115; or see wireless LAN, wireless network and PDA as reported by Wikipedia) including both the player's wager information and the identification code in an encrypted form (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs 1-15D), a device configured to communicate an encryption code to the wireless gaming device prior to the wagering information being entered by the player (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs 1-15D), the wireless gaming device configured to encrypt the signal using the encryption code prior to the transmission of the signal including the player's wager information and the identification code (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs. 1-15D),



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wager amount register and account balance register (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs. 1-15D, specifically, Fig 1A-1B and 2-3 shows wager and total amount available displayed on screen and thus, memory such as register is inherent for storing wager amount and amount available, and banking module and account balance is discussed therein), a card reader/writer including smart card (4:29, ref 91), an encryption key and a decryption key (supra), a database (ref 16, 30), including storing in a chip or ROM an identifier corresponding to the identification code (17:32-18:25, 21:4-7, 24:15-26, 38:9-26, ref. 32, 34) further comprising steps providing the wireless gaming device (15:24-28, 16:4-19:16, 29:18-25, 37:19-24) comprising an entry apparatus (ref 86) for entering wagering information (supra), a transmitter (sic), an identification code stored on the wireless gaming device for identifying the wireless gaming device (3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 33:9-33:32, 34:24-35:9, ref. 32, 34), entering the wagering information into the entry apparatus (25:3-26:34, 30:15-31:4), transmitting the identification code and the wagering information in an encrypted form (sic), receiving and decrypting the transmitted identification code and wagering information (33:6-36), a display for displaying the wagering information (fig. 1A-1B, ref 18, 84), receiving monetary tender (26:35-29:28, 35:5-9), establishing an account having account balance (29:18-28, 34:24-35:9, figs 1-15D), associating a wireless device having a stored identification code stored on the wireless gaming device (3:2-13:32, 15:11-16:35, 18:18-25, 19:2-16, 24:15-26, 34:24-35:9, 38:9-25), providing the player the wireless device (sic), receiving the identification code and wagering information (32:18-33:36), registering the players wager in the database based on the wagering information and the identification code (24:15-26:34, 29:35-31:4, 34:24-36:8, fig 1-15D, esp. 4,

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7C, 9), debiting the account balance (30:15-31:23, fig. 7A), determining if the player wager wins a prize, and crediting account balance (30:15-31:23, fig. 7A), receiving the wireless device from player and tendering money to player based on the account balance (36:9-37:29, 40:13-41:23).

***Claim Rejections - 35 USC § 103***

11. Claim 7 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker. This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. Regarding claim 7, Walker (22:9-27, 24:15-26:34, 29:35-31:4, 34:24-36:8, fig 1-15D, esp. 4, 7C, 9) discloses claimed invention (*supra*) but does not clearly discuss string of characters such as selected wager elements being hexadecimal digits. An inventor does not need to discuss in their specification that which is old or conventional and preferably omits from their disclosure that which is conventional. Such is the case with Walker in that Walker does not disclose hexadecimal digits since it is conventional at least due to program language read by wireless device compiler, i.e. processor, translates inputs and program to assembler language which is in hexadecimal digits that is further translated to binary code of machine language. As further evidence thereto under MPEP 2131.01, as requested by remarks on page 17, see evidence from Wikipedia that hexadecimal is used in computer science/programming. Alternatively, the form of characters being hexadecimal (0-9 and A-F), or base sixteen, fails to patentably distinguish over Walker at least since it is notoriously well known for computer compiler or processor to translate program language to assembler language which uses hexadecimal digits prior to translating to binary or machine code in executing program. This is hornbook engineering or basic computer

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programming. In so far as Walker lacks hexadecimal digits, as alleged by Applicant, the use of hexadecimal digits fails to critically distinguish over form of digits used by Walker as same structure performing same function for same purpose in that the form of digits being hexadecimal fails to patentably distinguish over Walker. Regarding claim 19, Walker (16:21-35, 18:18-25, ref 23) discloses claimed system including a memory storing identification code (sic) including ROM chip that by happenstance is an EPROM. An inventor does not need to discuss in their specification that which is old or conventional and preferably omits from their disclosure that which is conventional. Such is the case with Walker in that Walker does not state chip is EPROM; however, such chips were conventional. As evidence only, Bergeron (4764666) or Sarbin (5179517) each discloses a memory storing an identification code where the memory is EPROM for ease of reprogramming data stored in ROM. Walker also uses smart card (sic). In the alternative, it would have been obvious to an artisan at a time prior to the invention to apply EPROM as known memory device to Walker to permit ease of reprogramming data stored in ROM. The form of memory being EPROM does not critically distinguish over memory of Walker as same structure performing same function for same purpose.

12. Claims 13, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Franchi (5770533). This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to argument is provided below and incorporated herein. Walker discloses claimed features of invention (sic) including a display and remote communication except LCD (claim 13) and infrared signals (claim 16, 25). However, in a related reference, Franchi (15:26-16:22) discloses a wireless handheld gaming device comprising an LCD screen and infrared signals. However, an

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LCD for displaying and infrared signals for communicating is each notoriously well known in gaming. Infrared signals permit wireless remote direct communication; while, LCD permits easy to read display. Franchi is analogous art at least due to either being in the field of applicant's endeavor or, is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as shown by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply LCD and infrared signals as notoriously well known or as taught by Franchi to improve the system, method and device of Walker for the predictable result to provide an easy to read display and to provide remote direct communication. Additional evidence under MPEP 2131.01, as requested by remark on page 17, as reported by Wikipedia the initial PDAs used IR for remote communication due to IR technology being less costly. Walker teaches use of PDAs as its handheld portable wireless wagering device.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker each in view of Pease (5326014). This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. Walker discloses claimed features but lacks disclosing bicolour light emitting diode. Use of LED as an indicator is well known in gaming. Pease disclose use of tricolour LED as an indicator (9:55-10:55). It is known in gaming

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to provide indication of either game state or device operability state. Pease is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as shown by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply bicolor LED as taught by Pease to improve the system, method and device of Walker for the predictable result of providing an indicator of operability or game state so as to alert user. Although, Pease provides use of LED to indicate another facet of game play, this does not teach away from claimed invention. It is known in gaming to provide indication of either game state or device operability state. The claimed function 'to indicate separately that the wagering information has been entered and wagering information has been transmitted' is a recitation pertaining to operational status indicator of device. Pease also teaches providing operational status as an indicator to user. Thus, the standard of patentability remains as what the prior art taken as a whole would have suggested to an artisan at a time prior to the invention. In this instance, Walker in view of Pease taken as a whole at a time prior to the invention suggests to an artisan a wireless gaming device including a bicolor LED to provide an indication of either game state or operability status to user.

14. Claims 2, 22, 28-34 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Woodfield (EP 0649102). This holding is maintained from prior action

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for cited claims, as amended, and is reiterated below with consideration of amended language.

Response to arguments is provided below and incorporated herein. Walker discloses claimed system, method and device (supra) including encryption and decryption of transmitted signals except periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver (claim 2), periodically polling the wireless gaming device to determine whether the player has entered wagering information (claim 22), the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered (claim 28) and the wireless gaming device is periodically polled by the receiver (claim 29). Woodfield discloses system, device and method for transmitting wagering information while commanding placing of bets (4:4-15:24, figs. 1-4) comprising a wireless gaming device that includes an identification code (7:15-16), entry apparatus (6:6-18, refs. 15-16), and transmitter (18, 9), a receiver (4, 7, 8, 27) for receiving identification code and wagering information (15:16-24), the receiver polling the wireless gaming device (7:30-8:5, 15:16-24) to determine whether the player has entered wagering data to be transmitted. Woodfield teaches claimed polling by a receiver (7:15-8:5, 15:16-24) so as to conserve power (7:30-43) to include periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver (7:15-8:5, 15:16-24) periodically polling the wireless gaming device to determine whether the player has entered wagering information (sic), the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered (sic) and the wireless gaming device is periodically polled by the receiver (supra) such that a receiver periodically polls the wireless gaming device to determine if new data has been entered where

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data is environment of use such as wagering and Woodfield clearly states use of wireless device to place bets on sporting events, i.e. wagering. Woodfield is analogous art for either being in the field of applicant's endeavor or, being reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as shown by the references. In consideration of US Supreme Court decision in *KSR*, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver, periodically polling the wireless gaming device to determine whether the player has entered wagering information, the transmitter transmitting the signal when the receiver polls the wireless gaming device to determine that the wagering information has entered and the wireless gaming device is periodically polled by the receiver as taught by Woodfield to improve the system, method and device of Walker for the predictable result to conserve power. The standard of patentability is what the prior art taken as a whole suggests to an artisan at a time prior to the invention. In this case, when Walker in view of Woodfield is taken as a whole at a time prior to the invention, the combination suggests to an artisan a wireless gaming system, method or device comprising a wireless gaming device that includes periodically polls the wireless gaming device to determine whether the player has entered wagering information to be transmitted to the receiver, periodically polling the wireless gaming device to determine whether the player has entered wagering information, the transmitter transmitting the signal when the

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receiver polls the wireless gaming device to determine that the wagering information has entered and the wireless gaming device is periodically polled by the receiver so as to conserve power.

15. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Woodfield as applied to claim 28 above, and further in view of Franchi. This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. Walker in view of Woodfield discloses/suggests claimed wireless device (*supra*) except infrared signals. As in evidence above reiterated herein, Franchi (15:26-16:22) discloses a wireless handheld gaming device comprising infrared signals. However, infrared signals for communicating are notoriously well-known in gaming. Infrared signals permit wireless remote direct communication. Franchi is analogous art at least due to either being in the field of applicant's endeavor or, is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of skill in the art is as shown by the references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply LCD and infrared signals as notoriously well known or as taught by Franchi to improve the system, method and device of Walker in view of Woodfield for the predictable result to provide an easy to read display and to provide wireless direct communication.

Additional evidence under MPEP 2131.01, as requested by remark on page 17, as reported by



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Wikipedia the initial PDAs used IR for remote communication due to IR technology being less costly. Walker teaches use of PDAs as its handheld portable wagering device.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Jacobson (5785592). This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. Walker discloses/suggests claimed wireless device (supra) except a security tag, sensing apparatus as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as shown by references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art', it would have been obvious to an artisan at a time prior to the invention to apply a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed

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through the sensing apparatus as taught by Jacobsen to improve the system, method and device of Walker for increased security to alert security whenever terminal/device is in process of leaving gaming hall.

16. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Woodfield as applied to claim 28 above, and further in view of Jacobson (5785592). This holding is maintained from prior action for cited claims, as amended, and is reiterated below with consideration of amended language. Response to arguments is provided below and incorporated herein. Walker in view of Woodfield discloses/suggests claimed wireless device (supra) except a security tag, sensing apparatus as claimed. Jacobsen discloses a wireless handheld game device that is used for placing wagers teaching a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus for increased security to ensure terminal/device does not leave gaming hall. Jacobsen is analogous prior art since Jacobsen is either in the field of applicant's endeavor of wireless wagering handheld device (fig 1-4, ref 20, 96 and description thereof) or, at least is reasonably pertinent to the particular problem with which the applicant was concerned of improved security by adding electronic tag to device/terminal to alert security if wireless wagering device passes through portal (fig. 4), so as to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as shown by references. In consideration of decision in KSR, that 'known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the

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art', it would have been obvious to an artisan at a time prior to the invention to apply a security tag affixed to or included as part of wireless terminal and a sensing apparatus which activates an alarm when the security tag is passed through the sensing apparatus as taught by Jacobsen to improve the system, method and device of Walker in view of Woodfield for increased security to alert security whenever device is in process of leaving gaming hall.

***Response to Arguments***

17. Applicant's arguments with respect to claims 1-2, 4-26 and 28-44 have been considered but are moot in view of the new ground(s) of rejection.

18. Applicant's arguments filed 6/25/07 have been fully considered but they are not persuasive. Regarding remark on page 8 pertaining to priority, the Office disagrees and maintains that the only aspect that is common between disclosures of 08844764 and instant application is that each pertain to a wagering game where all claimed function/features herein are not adequately supported under 112(1) and thus remark is not well taken and no evidence has been submitted that shows '764 provides adequate support for wireless (communicating, transmitting, receiving), encryption, polling or any other function or feature as presently claimed and thus the priority of this application is filing date of parent application 09342150 such that art prior to 6/29/99 is available.

In response to argument on pages 8-9 regarding lack of adequate written description, enablement and indefiniteness, the scope of communication, receiving and transmitting includes wireless as form of communicating, receiving and transmitting and thus Office maintains that for the scope of invention includes wireless, the written description is not adequate, does not provide

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enablement and is indefinitely claimed at least since the form of such communication, receiving and transmitting is not defined in claim and as argued by Counsel.

In reply to alleged patentability over Walker '950 for claim 1 and 21 on pages 10-12, the Office disagrees since facts in holding above show Walker teaches all claimed functions/features including a wireless gaming device (ref 14, 82, handheld portable device, PDA, laptop) having an identification code, identifying the wireless gaming device (18:18-28, 19:2-21:22, 26:29-32, ref 22, 23, 32, 34, 212), entry apparatus configured to receive wagering information entered by a player the wagering information representing a wager request (abstract, 3:2-13:32, 16:21-18:17, 19:2-23:22, 24:15-26, 25:3-26:34, 33:9-33:36, 34:24-36:8, ref 14, 32, 34), and a transmitter configured to transmit a signal including both the player's wager information and the identification code together in an encrypted form (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs. 1-15D; handheld portable device, PDA or laptop from Walker includes transmitter to transmit both wager information and id code together in an encrypted form @ 7:4-17, 23:11-22). Thus, the opine on pages 10-12 is not persuasive as not considering teachings of reference as a whole in that the input by player of game elements, wager amount, player id and game computer id to be transmitted to host in encrypted form involves a wager request in that player input of lotto entry is a wager request.

Regarding remark on page 12-13 for claim 44 over Walker, the Office disagrees since evidence in holding shows Walker teaches all claimed functions and features including associating a wireless device having a stored identification code with the account, the identification code identifying the wireless device (3:2-13:32, 15:11-16:35, 18:18-25, 19:2-16,

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24:15-26, 34:24-35:9, 38:9-25) where a handheld portable device, pda or laptop is a dedicated gaming computer assigned to a player in that the unit id is stored in user database so as to ascertain which user has which device. This function is akin to a user having a library account checking out a book from that library where the library associates the id code of book to user account. Likewise in Walker, the unit id of the assigned dedicated gaming computer becomes associated with player account as taught therein, as would be interpreted by an artisan.

In reply to argument on page 13-14 regarding claims 7 and 19 that relies upon features of claim 1, the discussion above regarding claim 1 is incorporated herein regarding claims 7 and 19.

Regarding assertion on page 14 of claims 13, 16 and 25 that relies upon features of claims 1 and 21, the discussion above regarding claims 1 and 21 is incorporated herein for claims 13, 16 and 25.

In response to remark on page 14 regarding claim 14 that relies upon features in claim 1, the discussion above regarding claim 1 is incorporated herein regarding claim 14.

In reply to assertion on page 14-16 regarding claims 2, 22, 28-34, and 42-43 that relies upon features in claims 1 and 21, the discussion above regarding claims 1 and 21 is incorporated herein regarding claims 2, 22, 28-34, and 42-43. Specifically, regarding claim 28, facts show that Walker teaches an entry apparatus configured to receive wagering information from a player, the wagering information representing a wager request (abstract, 3:2-13:32, 16:21-18:17, 19:2-23:22, 24:15-26, 25:3-26:34, 33:9-33:36, 34:24-36:8, ref 14, 32, 34), and a processor in communication with the memory and the entry apparatus (ref 14, 82, handheld portable device, PDA, laptop), the processor configured to receive the wagering information from the entry apparatus and to encrypt the identification code and wagering information together using an

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encryption code received by the wireless gaming device prior to the entry of the wagering information by the player (abstract, 3:2-13:32, 16:21-18:17, 19:2-21:22, 23:11-22, 24:15-26, 25:3-26:34, 32:5-33:32, 34:24-35:9, 37:30-41:13, figs. 1-15D; handheld portable device, PDA or laptop from Walker includes transmitter to transmit both wager information and id code together in an encrypted form @ 7:4-17, 23:11-22).

In response to argument on page 16 regarding claim 35 that relies upon features in claim 28, the discussion above regarding claim 28 is incorporated herein regarding claim 35.

In reply to assertion on page 16 regarding claim 36 that relies upon features in claim 1, the discussion above regarding claim 1 is incorporated herein regarding claim 36.

In reply to remark on page 16-17 regarding claim 37 that relies upon features in claim 28, the discussion above regarding claim 28 is incorporated herein regarding claim 37.

Finally, Counsel request for references on page 17 was not a timely request since such requests are to have been provided in response to action that initially states well known statement. However, request on page 17 is not after action that initially provided those statements which in some cases the statements were made 5 or more years ago as having been made during prosecution of 09342150 and/or 08844794; however, references were cited.

### ***Conclusion***

19. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. This is a RCE of applicant's earlier Application No. 10796851. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714